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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,688	04/13/2004	Mayumi Tomikawa	1075.1259	4798
21171 7590 11/26/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER ELAHEE, MD S				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/822,688

**Applicant(s)**

TOMIKAWA ET AL.

**Examiner**

MD S. ELAHEE

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed on 07/17/2008. Claims 1 and 3-42 are pending. Claim 2 has been cancelled.

### ***Response to Arguments***

2. Applicant's arguments filed on 07/17/2008 Remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 21 and 25-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the phrase "the telephone number" in lines 27-28 is indefinite. There are two different "telephone number". It is unclear which "telephone number" is being referred to by the phrase.

***Reasons for Allowance***

5. Claims 3, 21 and 25-30 will be allowed after overcoming rejection under 35 U.S.C. 112, second paragraph.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 3 and 21, the prior art references, after having all the limitations, fail to teach a telephone number detecting unit for detecting whether a combination of the telephone number that is selected by said telephone number selecting unit and the telephone number that is obtained by said caller number obtaining unit matches a pre-determined combination. There is no suggestion in any of the references to teach the limitation.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1, 3-5, 7-12, 14-16, 18-20, 22-24, 31-34 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi Kobayashi (Japanese Pub. Number 02-284253) in view of Yoshio Kawakami (Japanese Pub. Number 10-336327).

Regarding claims 1, 3, 8-12, 14, 19, 39-42, with respect to Figures 1, 5, Hiroshi teaches an electronic mail (e-mail) system that has:

a receiver side A, unit 2 in Fig.1 [i.e., first information terminal] for transmitting and receiving sound information and text information; a receiver side B, unit 2 in Fig.1 [i.e., second information terminal] for transmitting and receiving sound information and text information in different ways; and a managing apparatus unit 1 in Fig.1, communicably interconnected between said first information terminal and said second information terminal, for managing an e-mail message that includes at least text information to be transmitted and received between said first information terminal and said second information terminal (paragraphs 0011, 0012),

said managing apparatus comprising:

a text information notifying unit 3 in Fig.1 notifying said second information terminal of the text information included in the e-mail message by sending said notification e-mail to said second information terminal (paragraph 0028);

a voice message [i.e., sound information] storing unit 6 in Fig.1 adapted to store sound information related to the e-mail message (paragraph 0019);

a telephone number selecting unit selecting a sound reply telephone number for use in inputting a sound reply as the sound information concerning sound reply related to the e-mail message to be transmitted from said first information terminal to said second information terminal (paragraphs 0025, 0026);

a telephone number notifying unit notifying said second information terminal of the sound reply telephone number selected by said telephone number selecting unit by inserting said sound reply telephone number into the notification-mail; and

a managing unit for managing association between the e-mail message and the sound information related to the e-mail message (paragraph 0021). (Note; devices 3 and 6 in Fig.1 function as a managing unit.)

However, Hiroshi does not specifically teach a notification e-mail creating unit creating a notification e-mail to be sent to said second information terminal by use of the text information in the e-mail message. Yoshio teaches a notification e-mail creating unit creating a notification e-mail to be sent to said second information terminal by use of the text information in the e-mail message (fig.2, 4; paragraph 0038). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi to incorporate the feature of a notification e-mail creating unit creating a notification e-mail to be sent to said second information terminal by use of the text information in the e-mail message as taught by Yoshio. The motivation for the modification is to do so in order to provide important information to a user.

Regarding claims 4 and 15, Hiroshi, as applied to claims 1 and 14, teaches that wherein said second information terminal includes a reply sound input unit for inputting sound information, as a reply to the e-mail message, through an audio communication line specified by the telephone number, wherein, of said managing apparatus, said sound information storing unit stores such sound information input as sound information related to the e-mail message, and wherein said managing apparatus further comprises a reply information notifying unit for notifying said first information terminal of reply information has been obtained from said second information terminal, based on the association managed by said managing unit (paragraphs 0011, 0012).

However, Hiroshi does not specifically teach reply sound input unit and a reply in sound information form. Yoshio teaches reply sound input unit and a reply in sound information form (paragraph 0003). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi to incorporate reply sound input unit and a reply in sound information form in Hiroshi's invention as taught by Yoshio. The motivation for the modification is to do so in order to generate voice response.

Regarding claims 5 and 16, Hiroshi, as applied to claims 4 and 15, does not specifically teach that said reply information is a reply e-mail message. Yoshio teaches that said reply information is a reply e-mail message (paragraph 0004). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi to incorporate said reply information as a reply e-mail message in Hiroshi's invention as taught by Yoshio. The motivation for the modification is to do so in order for a faster reply.

Regarding claims 7 and 18, Hiroshi, as applied to claims 5 and 16, does not specifically teach that said reply e-mail message has a pointer for use in accessing a section of said sound information storing unit in which section said sound information is stored. Yoshio teaches that said reply e-mail message has a pointer for use in accessing a section of said sound information storing unit in which section said sound information is stored (paragraph 0013). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi to incorporate said reply e-mail message having a pointer for use in accessing a section of said sound information storing unit (23) in which section said sound information is stored in Hiroshi's invention as taught by Yoshio. The motivation for the modification is to do so in order to expedite the response to an email by choosing the desired address.

Regarding claims 20 and 31, Hiroshi, as applied to claims 1 and 14, teaches an e-mail system wherein, if the e-mail message, transmitted from said first information terminal to said second information terminal, has information added thereto about the sound information, said managing apparatus further comprises:

a sound information obtaining unit for obtaining the sound information based on the information, added to the e-mail message, about the sound information, said sound information obtaining unit then storing the thus obtained sound information, as the sound information related to the e-mail message, to said sound information storing unit (paragraph 0021);

a sound information reproducing unit for reproducing the sound information stored in said sound information storing unit and a sound replay unit for replaying the sound information,



reproduced by said sound information reproducing unit, through said telephone number (paragraph 0029).

Regarding claims 22, 32 and 34, Hiroshi, as applied to claims 20 and 31, does not specifically teach that said managing prepares, based on the association managed by said managing unit, reproduction information, as a reproduction information notification e-mail message, that an e-mail message which is addressed to said second information terminal, and to which information about sound information is added, has been received from said first information terminal. Yoshio teaches that said managing prepares, based on the association managed by said managing unit, reproduction information, as a reproduction information notification e-mail message, that an e-mail message which is addressed to said second information terminal, and to which information about sound information is added, has been received from said first information terminal (paragraph 0007). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi to incorporate the feature of said managing preparing, based on the association managed by said managing unit, reproduction information, as a reproduction information notification e-mail message, that an e-mail message which is addressed to said second information terminal, and to which information about sound information is added, has been received from said first information terminal in Hiroshi's invention as taught by Yoshio. The motivation for the modification is to do so in order to minimize cost.

Regarding claim 23, Hiroshi, as applied to claim 22, does not specifically teach that said reproduction information notification e-mail message includes said telephone number selected by said telephone number selecting unit. Yoshio teaches that said reproduction information notification e-mail message includes said telephone number selected by said telephone number selecting unit (fig.1 and solution). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi to incorporate said reproduction information notification e-mail message including said telephone number selected by said telephone number selecting unit in Hiroshi's invention as taught by Yoshio. The motivation for the modification is to do so in order to lower the cost.

Regarding claim 24, Hiroshi, as applied to claim 22, does not specifically teach that said reproduction information notification e-mail message has a pointer for use in accessing information indicating said telephone number selected by said telephone number selecting unit. Yoshio teaches that said reproduction information notification e-mail message has a pointer for use in accessing information indicating said telephone number selected by said telephone number selecting unit (fig.1 and solution). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi to incorporate said reproduction information notification e-mail message has a pointer for use in accessing information indicating said telephone number selected by said telephone number selecting unit in Hiroshi's invention as taught by Yoshio. The motivation for the modification is to do so in order to choose an address such that a user can reply to an email to the desired address.

9. Claim 6, 17 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi in view of Yoshio further in view of Okada (US 6,463,134).

Regarding claims 6 and 17, Hiroshi in view of Yoshio, as applied to claims 5 and 16, does not specifically teach that said reply e-mail message has the sound information attached thereto, which has been received from said second information terminal and then stored in said sound information storing unit. Okada teaches that said reply e-mail message has the sound information attached thereto, which has been received from said second information terminal and then stored in said sound information storing unit (col.12, lines 61-64, col.13, lines 1-8). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Yoshio to incorporate said reply e-mail message having the sound information attached thereto, which has been received from said second information terminal and then stored in said sound information storing unit in Hiroshi's invention in view of Yoshio's invention as taught by Okada. The motivation for the modification is to do so in order to make a system more flexible and attractive to the consumer such that the system will be easily used by impaired person.

Regarding claim 35, Hiroshi in view of Yoshio, as applied to claim 1, does not specifically teach that an identification information setting unit for providing, if there are a plurality of such e-mail messages or if there are a plurality of such sound information items related to the individual e-mail messages, the individual e-mail messages or the individual sound information items with identification information for identifying the e-mail messages or the

sound information items, said managing unit managing association among the e-mail messages and the sound information items related to the e-mail messages and the identification information provided by said identification information setting unit. Okada teaches this limitation (col.12, lines 61-64, col.13, lines 21-37). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Yoshio to incorporate an identification information setting unit for providing, if there are a plurality of such e-mail messages or if there are a plurality of such sound information items related to the individual e-mail messages, the individual e-mail messages or the individual sound information items with identification information for identifying the e-mail messages or the sound information items, said managing unit managing association among the e-mail messages and the sound information items related to the e-mail messages and the identification information provided by said identification information setting unit in Hiroshi's invention in view of Yoshio's invention as taught by Okada. The motivation for the modification is to do so in order to make a system more reliable.

Regarding claim 36, Hiroshi in view of Yoshio, as applied to claim 35, does not specifically teach that an identification information inputting unit for inputting such identification information so as to specify the e-mail message or the e-mail-related sound information corresponding to the input identification information. Okada teaches that an identification information inputting unit for inputting such identification information so as to specify the e-mail message or the e-mail-related sound information corresponding to the input identification information (col.13, lines 21-37). Thus, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Yoshio to incorporate an identification information inputting unit for inputting such identification information so as to specify the e-mail message or the e-mail-related sound information corresponding to the input identification information in Hiroshi's invention in view of Yoshio's invention as taught by Okada. The motivation for the modification is to do so in order to provide email message to a user through id input device.

Regarding claim 37, Hiroshi in view of Yoshio, as applied to claim 1, does not specifically teach a sound guidance unit for providing a user of said second information terminal with guidance by voice. Okada teaches an identification information inputting unit for inputting such identification information so as to specify the e-mail message or the e-mail-related sound information corresponding to the input identification information (col.13, lines 32-29). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Yoshio to incorporate a sound guidance unit for providing a user of said second information terminal with guidance by voice in Hiroshi's invention in view of Yoshio's invention as taught by Okada. The motivation for the modification is to do so in order to make a system more user friendly to a visual impaired person.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi in view of Yoshio further in view of Enzmann et al. (US 6,516,203).

Claim 13 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Hiroshi in view of Yoshio does not specifically teach that said information about the sound input phone number is an address of a web page indicating the sound input phone number thereon or a pointer for use in accessing the web page. Enzmann teaches that said information about the sound input phone number is an address of a web page indicating the sound input phone number thereon or a pointer for use in accessing the web page (col.1, line 56-col.2, line 29, col.3, lines 8-27, 43-67, col.4, lines 1-28). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Yoshio to incorporate said information about the sound input phone number as an address of a web page indicating the sound input phone number thereon or a pointer for use in accessing the web page in Hiroshi's invention in view of Yoshio's invention as taught by Enzmann. The motivation for the modification is to do so in order to choose access a web page such that a user can receive more information.

11. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi in view of Yoshio further in view of Crockett et al. (US 2006/0256948).

Claim 38 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Hiroshi in view of Yoshio does not specifically teach a web guidance unit for providing a user of said first information terminal or a user of said second information terminal with a web page that shows guidance thereon. Crockett teaches a web guidance unit for providing a user of said first information terminal or a user of said second information terminal

with a web page that shows guidance thereon (page 4, paragraph 0043). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiroshi in view of Yoshio to incorporate a web guidance unit for providing a user of said first information terminal or a user of said second information terminal with a web page that shows guidance thereon in Hiroshi's invention in view of Yoshio's invention as taught by Crockett. The motivation for the modification is to do so in order to guide a user to get his desired information by browsing the internet.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to 03 whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Primary Examiner  
Art Unit 2614  
November 27, 2008